

Application No. 10/628,373

Docket No.: 20435-00141-US

**REMARKS****Status of Claims:**

Claims 1-44, 46-48, and 50-58 were pending. Claim 2 is hereby cancelled without prejudice to or disclaimer of any subject matter contained therein. The Applicant reserves the right to further prosecute the subject matter of the present application, including any canceled claims in subsequent division, continuation, and/or continuation-in-part application(s). Claims 1, 3-44, 46-48, and 50-58 are now pending. Each pending claim defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

**Claim Objections:**

Claim 1 was objected to in view of an informal recitation. Claim 1 is amended to recite "unsaturated."

**Rejections Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph:**

Claims 24-26 were deemed indefinite, Claims 24-26 are hereby amended to recite "Michael acceptor" as suggested by the Examiner.

The amended language does not introduce new matter.

**Rejections Under 35 U.S.C. § 103(a):**

Claims 1-9, 11-48, and 50-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostlie (5,876,805) in view of Moy (5,945,489).

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.<sup>1</sup> All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.<sup>2</sup> (MPEP § 2143.03). When evaluating the scope of a claim, every recitation in the claim must be

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<sup>1</sup> *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>2</sup> *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

Application No. 10/628,373

Docket No.: 20435-00141-US

considered. See e.g. *In re Ochiai*.<sup>3</sup> (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention. Specifically, Claims 1 and 46 are amended to recite a photolabile ketone formed as the Michael reaction product of a multifunctional acrylate and a  $\beta$ -dicarbonyl. Ostlie is silent as to the Michael Addition reaction and therefore fails to teach the chromophore of the present invention. Moy discloses the chromophore of the present invention. However, as the Examiner acknowledges, Moy does not disclose the reaction of a thiol with an acrylate functional group of a molecule comprising a photolabile ketone chromophore as disclosed in the present invention. Ostlie does not complete Moy because Ostlie does not disclose the reaction of a thiol with an acrylate group of a molecule comprising a photolabile ketone chromophore as disclosed in present invention.

**Conclusion:**


In view of the above, consideration and allowance are respectfully solicited.

Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

Respectfully submitted,



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<sup>3</sup> *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).